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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/645,065      | 08/24/2000  | Wendy Hufford        | GES-0005            | 2863             |

28062 7590 07/14/2004

BUCKLEY, MASCHOFF, TALWALKAR LLC  
5 ELM STREET  
NEW CANAAN, CT 06840

EXAMINER

PASS, NATALIE

ART UNIT PAPER NUMBER

3626

DATE MAILED: 07/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/645,065

**Applicant(s)**

HUFFORD, WENDY

**Examiner**

Natalie A. Pass

**Art Unit**

3626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 05 April 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 20,23,24,26,28 and 30-33 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 20,23,24,26,28 and 30-33 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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***Notice to Applicant***

1. This communication is in response to the amendment filed 05 April 2004. Claims 20, 23, 24, 26, and 28 have been amended. Claims 1-19, 21-22, 25, 27, and 29 have been canceled. Claims 30-33 have been newly added. Claims 20, 23, 24, 26, 28 and 30-33 remain pending.

***Claim Rejections - 35 USC § 112***

2. The rejection of claims 20, 23, 24, 26, 28 under 35 U.S.C. 112, second paragraph is hereby withdrawn due to the amendment filed 05 April 2004.

***Claim Rejections - 35 USC § 101***

3. The rejection of claims 20 and 23 under 35 U.S.C. 101 is hereby withdrawn due to the amendment filed 05 April 2004.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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5. Claims 20, 23, 24, 26, 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Heckman et al, U.S. Patent Number 5, 875, 431 for substantially the same reasons given in the previous Office Action (paper number 13). Further reasons appear hereinbelow.

(A) Claim 20 has been amended to include the recitation of

- "logging the alert in a database that is stored in a computer; and updating the database to indicate that corrective action has been taken relative to the logged alert, said corrective action comprising termination or modification of the identified business practice" in lines 8-11;

As per these new limitations, Heckman teaches teach a method as analyzed and discussed in the previous Office Action (paper number 13) further comprising

logging the alert in a database that is stored in a computer (Heckman; column 10, line 57 to column 11, line 61, column 12, lines 29-54, column 14, lines 5-38, column 15, lines 4-37, column 16, line 16 to column 17, line 20, column 18, line 64 to column 19, line 23, column 20, lines 17-47, column 24, lines 14-51, column 25, lines 1-36); and

updating the database to indicate that corrective action has been taken relative to the logged alert, said corrective action comprising termination or modification of the identified business practice (Heckman; column 10, line 57 to column 11, line 61, column 12, lines 29-54, column 14, lines 5-38, column 15, lines 4-37, column 16, line 16 to column 17, line 20, column 18, line 64 to column 19, line 23, column 20, lines 17-47, column 24, lines 14-51, column 25, lines 1-36).

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The remainder of claim 20 is rejected for the same reasons given in the prior Office Action (paper number 13, section 11, pages 5-6), and incorporated herein.

(B) The amendment to claim 23 appears to have been made merely to correct minor typographical or grammatical errors. While this change attempts to render the language of the claim smoother and more consistent, it otherwise affects neither the scope and breadth of the claims as originally presented nor the manner in which the claims were interpreted by the Examiner when applying prior art within the previous Office Action.

As such, the recited claimed features are rejected for the same reasons given in the prior Office Action (paper number 13, section 11, pages 6-7), and incorporated herein.

(C) Claim 24 has been amended to include the recitation of

- "computer readable program code means for updating the database to indicate that corrective action has been taken relative to the logged alert, said corrective action comprising termination or modification of the identified business practice" in lines 10-12;

As per these new limitations, article of manufacture claim 24 repeats the subject matter of method claim 20 as a set of article of manufacture elements rather than a series of steps. As the underlying processes of claim 20 have been shown to be fully disclosed by the teachings of Heckman in the above rejection of claim 20, it is readily apparent that the method disclosed by Heckman includes the article of manufacture to perform these functions. As such, these limitations are rejected for the same reasons given above for method claim 20, and incorporated herein.

The remainder of claim 24 is rejected for the same reasons given in the prior Office Action (paper number 13, section 11, page 7), and incorporated herein.

(D) Claim 26 has been amended to include the recitation of

- "computer readable program code means for updating the database to indicate that corrective action has been taken relative to the logged alert, said corrective action comprising termination or modification of the identified business practice" in lines 10-12;

As per these new limitations, computer program product claim 26 repeats the subject matter of method claim 20 as a set of computer program product elements rather than a series of steps. As the underlying processes of claim 20 have been shown to be fully disclosed by the teachings of Heckman in the above rejection of claim 20, it is readily apparent that the method disclosed by Heckman includes the computer program product to perform these functions. As such, these limitations are rejected for the same reasons given above for method claim 20, and incorporated herein.

The remainder of claim 26 is rejected for the same reasons given in the prior Office Action (paper number 13, section 11, page 7), and incorporated herein.

(E) Claim 28 has been amended to include the recitation of

- "update the database to indicate that corrective action has been taken relative to the logged alert, said corrective action comprising termination or modification of the identified business practice" in lines 6-8;

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As per these new limitations, system claim 26 repeats the subject matter of method claim 20 as a set of apparatus elements rather than a series of steps. As the underlying processes of claim 20 have been shown to be fully disclosed by the teachings of Heckman in the above rejection of claim 20, it is readily apparent that the method disclosed by Heckman includes the apparatus to perform these functions. As such, these limitations are rejected for the same reasons given above for method claim 20, and incorporated herein.

The remainder of claim 28 is rejected for the same reasons given in the prior Office Action (paper number 13, section 11, page 8), and incorporated herein.

(F) As per newly added claims 30-33, Heckman teaches a method, article of manufacture, computer program product and system as analyzed and discussed in claims 20, 24, 26, and 28 above and in the previous Office Action (paper number 13)

wherein the report is received by a company and concerns litigation to which the company is not a party (Heckman; column 16, line 37 to column 17, line 20, column 24, lines 8-12).

### ***Response to Arguments***

6. Applicant's arguments filed 05 April 2004 have been fully considered but they are not persuasive. Applicant's arguments will be addressed hereinbelow in the order in which they appear in the responses filed 05 April 2004.

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(A) At pages 6-7 of the 05 April 2004 response, Applicant argues that the limitations of claims 20, 23, 24, 26, 28 and newly added claims 30-33 are not taught or suggested by the applied reference. In response, all of the limitations which Applicant disputes are missing in the applied reference, including the newly added limitations, have been fully addressed by the Examiner as either being fully disclosed or obvious in view of the teachings Heckman, based on the logic and sound scientific reasoning of one ordinarily skilled in the art at the time of the invention, as detailed in the 35 USC § 103 rejections given in the preceding sections of the present Office Action and in the prior Office Action (paper number 13), and incorporated herein.

With respect to Applicant's argument at page 7 of the 05 April 2004 response that the applied reference fails to disclose "corrective action", as recited in newly amended claims 20, 23, 24, 26, and 28, it is respectfully submitted that Applicant ignores the clear and unmistakable teachings of Heckman with respect to providing a "computer-based, closed-loop legal strategic planning system ... having iterative convergence to an optimal strategy and dynamic tracking of current prevailing legal climates" and in which "[d]eviations (i.e., variances) between the target values and the actual values are ascertained" and "[t]he causes for the variances are corrected " Examiner interprets Heckman's correction of variances and corrections in the ongoing review of Heckman's Strategic Plan and "[t]he entire closed-loop process is repeated until the case is concluded" as corrective actions or modifications to the business practices (Heckman; Abstract, Figure 6, Item 65, column 23, lines 16-36, column 24, lines 13-20, column 25, lines 37-60).

With respect to Applicant's footnote at the bottom of page 7 as to the definition of the term "business practice", Examiner notes that business practices can include both practices or



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"ways of doing something" that are not open to legal dispute as well as those that are open to legal dispute.

With respect to Applicant's argument at page 7 of the 05 April 2004 response that the applied reference fails to disclose " wherein the report is received by a company and concerns litigation to which the company is not a party", as recited in newly added claims 30-33, and which is supported in the specification at page 3, lines 24-25, as noted by Applicant, Examiner interprets Heckman's teaching of "instructions as to how information regarding the case is to be routed (e.g., to Risk Management, to outside counsel, to a claims/legal department, to file, or to some other recipient" as reading on this limitation (Heckman; column 16, line 37 to column 17, line 20).

### ***Conclusion***

7. **THIS ACTION IS MADE FINAL.** See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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8. Any response to this final action should be mailed to:

**Box AF**

Commissioner of Patents and Trademarks  
Washington D.C. 20231

**or faxed to:**

(703) 305-7687.

For formal communications, please mark  
"EXPEDITED PROCEDURE".

For informal or draft communications, please label  
"PROPOSED" or "DRAFT" on the front page of the  
communication and do NOT sign the communication.

Hand-delivered responses should be brought to Crystal Park 5,  
2451 Crystal Drive, Arlington, VA, Seventh Floor (Receptionist).

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Natalie A. Pass whose telephone number is (703) 305-3980. The examiner can normally be reached on Monday through Thursday from 9:00 AM to 6:30 PM. The examiner can also be reached on alternate Fridays.

10. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas, can be reached at (703) 305-9588. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Receptionist whose telephone number is (703) 308-1113.

NP

Natalie A. Pass

July 9, 2004

  
**ALEXANDER KALINOWSKI**  
**PRIMARY EXAMINER**